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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/539,859	03/30/2000	PAUL KUPRIONAS	FIS990239US1	8359

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EXAMINER

KENDALL, CHUCK O

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 06/30/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/539,859

Applicant(s)

KUPRIONAS, PAUL

Examiner

Chuck Kendall

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to the application filed 04/12/04

Claims 1 – 20 have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S. C. 103(e) which forms the basis for all obviousness rejections set forth in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 - 7 and 9 - 20 are rejected under 35 U.S.C. 103(e) as being unpatentable over Corbin USPN 5,138,712, in view of McGuire et al. USPN 6,493,871 131 and further in view of Misra et al. USPN 6,189,146 B1.

Regarding claims 1,9 &13, Corbin discloses a method (Col.23: lines 23 - Col.25: lines 43), apparatus (25:44 - 28: 28), storage device (5:15 - 20) for installing licensed software on an end user's computer, comprising:

providing an end user computer having a program storage device and a unique, computer identifier distinguishing the end user computer from other computers (2:60-65, see license token);

providing a network computer having access to a program storage device containing software for license to end users and a program storage device containing a database listing computer identifiers licensed to run the software (3:1-5, see license library for listing);

using the network computer to contact the end user computer and determine its end user computer identifier (3:1-5, see verify license information, for determining);

verifying listing of the end user computer identifier in the network computer database; based on verification that the end user computer identifier is listed in the network computer database,(3:1-5, see library for database, also 5:45 - 65, for Data table showing ids and end user elements, also see 2:60-65);

downloading the software from the network computer(6:40 - 45 for download see transmit, also see 6:62 – 67); and

installing the downloaded software on the end user computer program storage device (6:62-65, also see 7:5-10). Corbin doesn't explicitly disclose, software selected from the group consisting of programs to be executed by the end user's computer and database information.

However, McGuire does disclose this feature (7:47-52, see update data and database). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine, Corbin with McGuire because, listing and selecting software from a central location for downloading as needed in a distributed architecture, makes loading updated and needed files more efficient. Corbin as modified by McGuire doesn't disclose such that the downloaded and installed software is not in a form that may be transferred from the end user computer and installed on another.

However, Misra does disclose this functionality in analogous art (Col. 15: 27-35). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Corbin as modified with McGuire with Misra because, it would prevent the software license from being copied from one client machine to another (Col. 15:27-30).

Regarding claims 2 &10, the method of claim 1, wherein the unique computer identifier is selected from the group consisting of a BIOS serial number and a network adapter address (9:5 -10, for address see host name and domain, for Bios serial number, see host ID).

Regarding claims 3 & 11, the method of claim 1, wherein on installation on the end user computer program storage device, the software comprises a program for execution on the end user computer (8:65-67, see item #56).

Regarding claims 4 & 12, the method of claim 1, wherein the network computer includes a plurality of different software and, prior to downloading the software, further including:

identifying to the end user computer all of the software on the network computer program storage device listed as licensed by the computer identifier of the end user computer(fig 2, see license server and library); and

sending from the end user computer to the network computer a selection of the software to be downloaded, and thereafter downloading and installing on the end user computer program storage device the selected software.

Regarding claim 5, the method of claim 4, wherein the identification to the end user computer of all the software on the network computer program storage device listed as licensed by the computer identifier of the end user computer is by an executable program on a program storage device of the network computer 6:40-45 for download see transmit, also see 6:62-65, also see 7:5-10).

Regarding claim 6, the method of claim 5, wherein prior to identifying to the end user computer the software on the network computer program storage device, further including: sending to the network computer, from the end user computer, a command to run the program identifying to the end user computer the software listed as licensed by the computer identifier of the end user computer (7 25-40, see binder, and contents of license servers).

Regards to claim 7, the method of claim 6, wherein the program identifying to the end user computer the software listed as licensed by the computer identifier is not installed on the end user computer (7:24-30, 35-40).

Regards to claim 14, see reasoning in claim 2.

Regards to claim 15, the method of claim 13 wherein the network computer includes a plurality of different software and, prior to downloading the software, further including:

identifying to the end user computer all of the software on the network computer program storage device listed as licensed by the computer identifier of the end user computer (7:24-30, 35-40); and

sending from the end user computer to the network computer a selection of the software to be downloaded (7:27-33, see listing products available into binding file), and thereafter downloading and installing on the end user computer program storage device the selected software (7:40-43, also refer back to transmitting for downloading).

Regards to claim 16, the method of claim 15 wherein the identification to the end user computer all of the software on the network computer program storage device listed as licensed by the computer identifier of the end user computer is by an executable program on a program storage device of the network computer (7:24-40).

Regards to claim 17, the method of claim 16 wherein prior to identifying to the end user computer the software on the network computer program storage device, further including: sending to the network computer, from the end user computer, a command to run the program identifying to the end user computer the software listed as licensed by the computer identifier of the end user computer (7:24 -30, 35-40).

Regards to claim 18, which is the program storage device version of claim 1, see rationale as previously discussed above.

Regards to claim 19, which is the product version of claim 1, see rationale as previously discussed above.

Regards to claim 20, which is the article of manufacture version of claim 1, see rationale as previously discussed above.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 8 is rejected under 35 U.S.C. 103(x) as being unpatentable over Corbin USPN 5,138,712, in view of McGuire et al. USPN 6,493,871 B1, further in view of Misra et al. USPN 6,189,146 as applied in claim 1, and further in view of Bartholomew et al. USPN 6,202,209 B1.

Regarding claim 8, Corbin as, modified by McGuire discloses all the claimed limitations as applied in claim 1. The combination of Corbin, McGuire, and Misra does not explicitly disclose end user computer program storage device contains a damaged version of the software to be downloaded, and wherein the installation of said software corrects the damaged software. However, Bartholomew does disclose this feature (9:10-15). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Corbin as modified by McGuire and Misra with Bartholomew to implement the instant claimed invention because, diagnosing the new application code and ascertaining the integrity of the code when downloaded ensures efficient downloading, (Bartholomew, 9:5-15).

Response to Arguments

6. Applicant's arguments filed 04/12/2004 have been fully considered but they are not persuasive.

Argument (1), Applicant argues that on page 16, 2nd paragraph, that Corbin doesn't disclose " downloading the executable software program or database...".

Response (1), Contrary to Applicant's argument, Examiner believes that Corbin does disclose this feature. In 2: 60 – 65, Corbin states " When a user wishes to **run a software application**, the licensing library invokes a call to request a license token from the license server." Also in 6:62 – 67, Corbin discloses, " The application integrated with the application specific license access module (LAM) 27 may be

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distributed by the software vendor for installation on one of the computers in the network using any well known distribution medium in the art", here Examiner believes downloading to be a well known distribution medium in the art. The executable software program as claimed by Applicant is equivalent to the software program run by Corbin. As noted the software program works together with the license token to achieve its functionality and as such is equivalent to Applicant's limitations.

Argument (2), In page 17, 3rd paragraph, Applicant further argues that McGuire does not disclose "first verifying licensing, and then based on such licenses, downloading from a network computer and installing to the end user's computer software...".

Response (2), As set forth above in claim 1, Corbin is used to show this limitation and not McGuire. In Corbin 2: 60 – 65, Corbin shows when **running the software program** verifying the license and upon verification transmitting the license for the **software application**. And as previously discussed above in first argument the **integrated application license may be distributed** to one of the computers in the **network (end users)**.

Regarding Applicant's argument in Misra, Applicant simply rehashes arguments from Corbin and McGuire, which have been previously discussed above.

Conclusion

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Correspondence Information

8. Any inquires concerning this communication or earlier communications from the examiner should be directed to Chuck O. Kendall who may be reached via telephone at (703) 308-6608. The examiner can normally be reached Monday through Friday between 8:00 A. M. and 5:00 P. M. est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached at (703) 305-4552.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the! Group receptionist whose telephone number is (703) 305-3900.

For facsimile (fax) send to central FAX number 703-872-9306 and 703-7467240 draft.

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Software Engineer Patent Examiner



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PRIMARY PATENT EXAMINER